

Reply to Non-Final Office Action  
Attorney Docket No.: NOR-091 (11499TCUS01U)  
U.S. Serial No.: 09/645,186

### **REMARKS**

Applicants have carefully reviewed and considered the current Office Action and the references cited therein. Claims 1-3, 5-14, 17-22, 24-33, 36-41, 43-54, and 57-59 were pending in the present application. Claims 1, 5, 13, 14, 20, 24, 32, 33, 39, 43, 53, and 54 are amended; Claims 3, 6, 7, 9-12, 17-19, 22, 25, 26, 28-31, 36-38, 41, 44, 45, 47-50, and 57-59 are canceled; and no claims are added. As a result, Claims 1, 2, 5, 8, 13, 14, 20, 21, 24, 27, 32, 33, 39, 40, 43, 46, and 51-54 are now pending in this application.

#### **Rejection of Claims 1, 2, 39, and 40 under 35 U.S.C. §102(e)**

The Examiner has rejected Claims 1, 2, 39, and 40 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,778,535 issued to Ash et al. ("Ash"). Applicants respectfully request this rejection be withdrawn in light of amendments made herein and accompanying remarks. Applicants do not admit that Ash is prior art and hereby reserve the right to show, at a later date, that Applicants invented the present invention prior to Ash's effective date. However, for purposes of the present Reply, Applicants contend that the present invention, as claimed, is patentable even if Ash is assumed to be prior art.

None of the cited art, taken or alone or in combination, teaches or suggests Claim 1 as amended. Claim 1 has been amended to require selecting a network path having sufficient network resource available, allocating the network resource to the data path when the network path has an acceptable cost, and taking network resource from a network path having a priority lower than the predetermined priority when no network path having sufficient network resource and acceptable cost is selected.

On page 5 of the current Office Action, the Examiner combined Ash with U.S. Patent No. 5,687,167 issued to Bertin et al. ("Bertin") to reject Claims 11-12, 22, 24-26, 30-31, 41, and 49-50. Applicants agree with the Examiner's assertion that Ash "does not teach taking a portion of the network resource used by a data path at a different priority to accommodate the data path at the predetermined priority level." The Examiner also states that Bertin teaches taking bandwidth from a link with lower priority and giving it to a link of higher priority that needs it. Since Claim 1, as now amended, is similar to one or more of these rejected claims, the combination of Ash and Bertin is addressed here.

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Ash and Bertin are not properly combinable to make a prima facie case of obviousness. The Federal Circuit has repeatedly stated that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or motivation supporting the combination. Moreover, the teaching, suggestion, or motivation must come from the art itself. That is, the prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination. Failure of the Examiner (or Board) to provide the necessary suggestion or motivation creates a presumption that the combination of references selected by the Examiner to support the obviousness rejection were based on hindsight.

There is no teaching, suggestion, or motivation in the cited art to combine the art. First, Ash does not suggest the need to take bandwidth from another path if no path with sufficient bandwidth is found. In fact, Ash addresses the issue by stating that if no path having sufficient available bandwidth is found, the call is ultimately blocked. At column 5, lines 35-40, Ash states the following:

If the originating switch fails to find a path to the destination switch and there are other terminating switches that can also complete the call, then the originating switch uses the same PNNI-base method to route the call to a subsequent terminating switch. Otherwise, the call is blocked.

The only other place in Ash where this is addressed is the last sentence in the Abstract: "If no path is found, the call is ultimately blocked." Accordingly, there is no teaching or suggestion in Ash to take network resource from another path at any time for any reason.

Second, while Bertin teaches a method of preemption in great detail, Bertin does not appear to teach or suggest the point at which preemption is required by the present invention. In Bertin, a Path Selection process first chooses a path (actually two paths, one for each direction) and then a Bandwidth Reservation process reserves bandwidth on the chosen path. The Bandwidth Reservation process then either reserves available bandwidth on each link of the chosen path or, alternately, preempts connections from using a link if the new connection has a higher priority. *See* Column 12, line 59 to Column 14, line 4. Thus, Bertin does not teach or suggest *looking for a different path that might have sufficient bandwidth* before preempting bandwidth on a chosen path.

In the present invention, on the other hand, the taking of network resource from a network path having lower priority only occurs when no network path having sufficient network

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resource (e.g., bandwidth) and acceptable cost is found. The present invention first selects a network path having sufficient network resource available. This generally involves selecting a network path and checking the selected path for sufficient network resource. If this selected path does not have sufficient network resource, then *another network path is selected*. This continues until either there are no more network paths to be selected or a selected network path is found that has sufficient network resource. Thus, the present invention, unlike Bertin, will select multiple paths until one is found that has sufficient network resource or all network paths have been selected. In the present invention, unlike Bertin, network resource is taken only when no network path having sufficient network resource and acceptable cost is selected.

Even if Ash and Bertin were properly combinable, together they do not teach or suggest the present invention. Ash does not teach or suggest a need for preemption and Bertin does not teach or suggest first looking at multiple paths for sufficient bandwidth before preempting. According, Applicants contend that Claim 1, as amended is patentable over the cited art.

Claim 39 has been amended to contain essentially the same limitations as amended Claim 1. Claims 2 and 40 depend from Claim 1 and Claim 39, respectively. Applicants contend that Claims 2, 39, and 40 are patentable over the cited art for the same reasons that Claim 1 is contended to be patentable over the cited art.

**Rejection of Claims 5, 7, 9-10, 20-21, 24, 28-29, 47-49, and 51-52 under 35 U.S.C. §103(a)**

The Examiner has rejected Claims 5, 7, 9-10, 20-21, 24, 28-29, 47-49, and 51-52 under 35 U.S.C. §103(a) as being unpatentable over Ash. Of these, only Claims 5, 8, 20-21, 24, 51, and 52 remain pending. Applicants respectfully traverse the rejection.

The Examiner has taken Official Notice to reject Claim 5 over the cited art. It is incorrect for an Examiner to formulate a suggestion or motivation based on current knowledge. Such suggestion or motivation must exist before the date of the invention.

Independent Claim 20 has been amended to contain essentially the same limitations as amended Claim 1 and is patentable over the cited art for the same reasons, stated above, that Claim 1 is contended to be patentable over the cited art. Dependent Claims 5, 8, 21, 24, 51, and 52 all depend from claims that contain essentially the same limitations as amended Claim 1 and are patentable over the cited art for the same reasons, stated above, that Claim 1 is contended to

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be patentable over the cited art. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

**Rejection of Claims 3, 6, 43-45 under 35 U.S.C. §103(a)**

The Examiner has rejected Claims 3, 6, 43-45 under 35 U.S.C. §103(a) as being unpatentable over Ash as applied to Claims 5, 7, 9-10, 20-21, 24, 28-29, 47-48, and 51-52 above, and further in view of U.S. Patent No. 6,034,946 issued to Roginsky et al. ("Roginsky"). Of these, only Claim 43 remains pending. Dependent Claims 43 depends from a claim (i.e., Claim 39) that contains essentially the same limitations as amended Claim 1 and is patentable over the cited art for the same reasons, stated above, that Claim 1 is contended to be patentable over the cited art. Accordingly, Applicants respectfully request that this rejection be withdrawn.

**Rejection of Claims 8, 13, 17-19, 27, 32, 36-38, 46, 53, and 57-59 under 35 U.S.C. §103(a)**

The Examiner has rejected Claims 8, 13, 17-19, 27, 32, 36-38, 46, 53, and 57-59 under 35 U.S.C. §103(a) as being unpatentable over Ash as applied to Claims 5, 7, 9-10, 20-21, 24, 28-29, 47-48, and 51-52 above, and further in view of U.S. Patent No. 6,665,273 issued to Goguen et al. ("Goguen"). Of these, Claims 8, 27, 32, 46, and 53 remain pending. All these claims contain essentially the same limitations as amended Claim 1 and are patentable over the cited art for the same reasons, stated above, that Claim 1 is contended to be patentable over the cited art. Accordingly, Applicants respectfully request that this rejection be withdrawn.

**Rejection of Claims 11-12, 22, 24-26, 30-31, 41, and 49-50 under 35 U.S.C. §103(a)**

The Examiner has rejected Claims 11-12, 22, 24-26, 30-31, 41, and 49-50 under 35 U.S.C. §103(a) as being unpatentable over Ash as applied to Claims 5, 7, 9-10, 20-21, 24, 28-29, 47-48, and 51-52 above, and further in view of U.S. Patent No. 5,687,167 issued to Bertin et al. ("Bertin"). Of these, only Claim 24 remains pending. Claim 24 contains essentially the same limitations as amended Claim 1 and are patentable over the cited art for the same reasons, stated above, that Claim 1 is contended to be patentable over the cited art. Accordingly, Applicants respectfully request that this rejection be withdrawn.

**Rejection of Claims 14, 33, 54 under 35 U.S.C. §103(a)**

The Examiner has rejected Claims 14, 33, 54 under 35 U.S.C. §103(a) as being unpatentable over Ash and Goguen as applied to Claims 8, 13, 17, 27, 32, 37, 53, and 57 above, and further in view of Roginsky. Claims 14, 33, and 54 contain essentially the same limitations

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as amended Claim 1 and are patentable over the cited art for the same reasons, stated above, that Claim 1 is contended to be patentable over the cited art. Accordingly, Applicants respectfully request that this rejection be withdrawn.

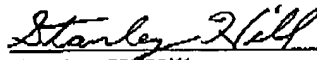
### CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance for the reasons state above and notification to that effect is earnestly requested. If the Examiner believes that a telephone conversation with the Applicants' representative would facilitate prosecution of this application in any way, the Examiner is cordially invited to telephone the undersigned at (508) 303-2003. If necessary, please apply any additional fees, or credit overpayments, to Deposit Account 50-2295.

Respectfully submitted,

Date: December 12, 2005  
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The undersigned hereby certifies that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service, with sufficient postage as first class mail, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Stanley K. Hill

Date: December 12, 2005

